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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,724	10/07/2003	Gary Johnston	WEAT/0487	8287
36735	7590	09/22/2005		
PATTERSON & SHERIDAN, L.L.P. 3040 POST OAK BOULEVARD, SUITE 1500 HOUSTON, TX 77056			EXAMINER STEPHENSON, DANIEL P	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,724

Applicant(s)

JOHNSTON ET AL.

Examiner

Daniel P. Stephenson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-36 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-36 and 39-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mating of the back bearing body with the piston must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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3. Claims 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson '532. Simpson '532 (Figs. 2 and 20) discloses an expander tool (304) for use in a wellbore. The expander tool has a body (102) having at least one recess (114) formed therein. There is an expansion assembly disposable in the at least one recess. The expansion assembly has a piston (120) that is outwardly extendable from the body in response to a radially outward force and a roller (116) rotationally disposed on a shaft. The roller and the shaft are constructed and arranged on the piston at an angle relative to the longitudinal axis of the expander tool. The recess that holds the piston is also at this angle, which is skewed from the longitudinal. It is inferred from the drawings that this angle is at least 10 degrees from the longitudinal axis and the centerline of the expander tool. There is a bearing body (118) adjacent to the roller on either end of the roller. The outer ends of the piston have a portion that is substantial enough to prevent the piston from tipping in the recess. The assembly has, at its ends, enough width to prevent tilting about an axis perpendicular to the longitudinal axis of the tool.

4. Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Clark '891. Clark '891 (Figs. 1, 3 and 4) discloses an expander tool for use in a wellbore. The expander tool has a body (30) having at least one recess (34) formed therein. There is an expansion assembly disposable in the at least one recess. The expansion assembly has a piston (40) that is outwardly extendable from the body in response to a radially outward force and a roller (35) rotationally disposed on a shaft (37). The roller and the shaft are constructed and arranged on the piston at an angle relative to the longitudinal axis of the expander tool. It is inferred from the drawings that this angle is at least 10 degrees from the longitudinal axis and the centerline of the expander tool. In addition, it is also inferred that the roller creates an angle with the centerline of at least 20

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degrees. The outer ends of the piston have a portion that is substantial enough to prevent the piston from tipping in the recess. The outer ends of the piston have a portion that is substantial enough to prevent the piston from tipping in the recess. The assembly has, at its ends, enough width to prevent tilting about an axis perpendicular to the longitudinal axis of the tool.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 6, 10, 11, 15-19, 29-31, 33-36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson '532 in view of Clark '630 and the pre-grant publication '704 to Jackson. Simpson '532 shows all the limitations of the claimed invention, except, it does not disclose that there is a bearing portion includes a bearing portion between the rolling body and the piston that rotates with the roller. Nor does it disclose that the roller and shaft are constructed at an angle relative to the longitudinal axis of the expander tool. Nor does in disclose that the roller is tapered. Clark '630 (Fig. 1) discloses a thrust washer that is placed into a recess for the roller along with the roller. In using the roller the thrust washer will rotate with the roller. The roller and shaft are constructed at an angle relative to the longitudinal axis of the expander tool. The roller is also tapered. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the thrust washer and angle of Clark '630 with the apparatus of Simpson '532. This would be done to provide further wear protection as would

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be cost effective and lessen the need to replace rollers. In addition the angle would be used to allow for greater variation on the thrust placed on the expansion of the tubular.

Simpson '532 in view of Clark '630 shows all the limitations of the claimed invention, except, it does not disclose that the bearing member is matable to the roller to prevent relative rotation between the two, or that there is a cooling channel disposed between bearing members. Jackson '704 discloses a thrust bearing washer that can be attached to one surface using pins before it rubs against another surface. The thrust washer has a cooling channel for the ingress of cooling/lubrication fluid. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pins and bearing of Jackson '704 with the bearing of Simpson '532 in view of Clark '630. This would be done because it is common in the art of bearings to mate the bearing in relation to one surface if the bearing is in contact with another surface and to place a cooling channel between bearing surfaces.

With regards to the limitation that the back bearing body be matable with the piston. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a separate bearing surface that is mated to the piston, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

7. Claims 7-9 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson '532 in view of Clark '630 and Jackson '704 as applied to claims 5, 15, 30 and 35 above, and further in view of the pre-grant publication '769 to Whang. Simpson '532 in view of Clark '630 and Jackson '704 shows all the limitations of the claimed invention, except, it does not disclose that there is a helical groove formed on the bearing body to provide for the ingress

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of fluid so that there is a fluid cushion between the stationary bearing body and the rotating bearing. Whang '769 discloses a thrust bearing with helical (58) grooves that allow the ingress of fluid so that there is a lubricating cushion between the thrust bearing and what it is next to. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the grooves of Whang '769 on the thrust bearing of Simpson '532 in view of Clark '630 and Jackson '704. This would be done to preserve the thrust bearing as taught by Whang '769.

8. Claims 12, 13, 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson '532 in view of Clark '630 and Jackson '704 as applied to the claims above, in further view of the WIPO document '728 to Simpson et al. Simpson '532 in view of Clark '630 and Jackson '704 shows all the limitations of the claimed invention, except, it does not disclose that there is a plurality of rollers disposed on the shaft with differing diameters and different rates of rotation. WIPO '728 (Fig. 8 and page 19 line 31- page 20 line 2) discloses a roller in which there is a plurality of rollers (630) at different diameters and different rates of rotation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the separate rollers as disclosed in WIPO '728 in the apparatus of Simpson '532 in view of Clark '630 and Jackson '704. This would be done to prevent slipping as taught by WIPO '728.

With regards to the limitation that there be a bearing between the rollers. It is Officially Noticed that whenever two surfaces are in sliding engagement adjacent each other a thrust bearing is often used as a means of protection, as is the case with the current apparatus between the roller and the piston. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place a bearing between the adjacent rollers in the apparatus of Simpson '532 in view of Clark '630, Jackson '704 and WIPO '728.

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9. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson '532 in view of Clark '630, Jackson '704 and WIPO '728 as applied to claim 24 above, and further in view of Whang '769. Simpson '532 in view of Clark '630, Jackson '704 and WIPO '728 shows all the limitations of the claimed invention, except, it does not disclose that there is a helical groove formed on the bearing body to provide for the ingress of fluid so that there is a fluid cushion between the stationary bearing body and the rotating bearing. Whang '769 discloses a thrust bearing with helical (58) grooves that allow the ingress of fluid so that there is a lubricating cushion between the thrust bearing and what it is next to. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the grooves of Whang '769 on the thrust bearing of Simpson '532 in view of Clark '630, Jackson '704 and WIPO '728. This would be done to preserve the thrust bearing as taught by Whang '769.

Response to Arguments

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Stephenson whose telephone number is (571) 272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Bagnell
Supervisory Patent Examiner
Art Unit 3672

DPS 